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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,718	07/06/2004	Nils Bottke	53209	7194

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EXAMINER

KEYS, ROSALYND ANN

ART UNIT PAPER NUMBER

1621

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,718

Applicant(s)

BOTTKE ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/6/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Status of Claims

1. Claims 1-10 are pending.
Claims 1, 2, and 5- 10 are rejected.
Claims 3 and 4 are objected.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on July 6, 2004 has been considered by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 2 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wender et al. (US 2,682,562).

Wender et al. teach reduction of aromatic aldehydes and aromatic alcohols by reaction with hydrogen in the presence of a carbonyl of cobalt at elevated temperature and pressure (see entire disclosure, in particular column 1, line 6 to column 4, line 64, example 7 and example 11). The catalyst may be formed in situ by adding the finely divided metal, or an organic or inorganic salt of the metal to the reaction mixture (see column 3, lines 37-53). The reaction temperature may vary between 70° and 250°C (see column 4, lines 27-39). The pressure is at least 40 atm (see column 4, lines 40-52). The reaction can take place with or without a solvent (see column 4, lines 56-64).

The instant method differs from the method of Wender et al. only in that the instant starting compound and final product contain additional hydroxyl or methoxy groups. However, the starting compounds are analogous in that they each either a benzaldehyde or a benzyl alcohol, thereby producing the corresponding toluene derivative.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the process of Wender et al. with the expectation of obtaining the desired product because he would have expected the analogous starting materials to react similarly. Further, once the general reaction has been shown to be old, the burden is on the applicant to present reason or authority for believing that a group on the starting compound would take part in or affect the basic reaction and thus alter the nature of the product or the operability of the process. See *In re Neunebauer et al.* (CCPA 1964) 330 F2d 353, 141 USPQ 205 and *In re Boe et al.* (CCPA 1974) 505 F2d 1297, 184 USPQ 38.

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7. Claims 1, 2, 5, 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nightingale et al. (J. Organic Chemistry, Vol. 14, 1949, pp. 1089-1093).

Nightingale et al. teach preparing alkylbenzenes from the corresponding methoxy aromatic aldehydes by hydrogenating said aldehydes over copper-chromium oxide at an initial hydrogen pressure of 220-340 atm and a temperature of 184°-250°C (see entire disclosure, in particular the summary on page 1093).

The instant method differs from the method of Nightingale et al. only in that the instant starting compound and final product contain additional hydroxyl or methoxy groups. However, the starting compounds are analogous in that they each either a benzaldehyde or a benzyl alcohol, thereby producing the corresponding toluene derivative.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the process of Nightingale et al. with the expectation of obtaining the desired product because he would have expected the analogous starting materials to react similarly. Further, once the general reaction has been shown to be old, the burden is on the applicant to present reason or authority for believing that a group on the starting compound would take part in or affect the basic reaction and thus alter the nature of the product or the operability of the process. See *In re Neunebauer et al.* (CCPA 1964) 330 F2d 353, 141 USPQ 205 and *In re Boe et al.* (CCPA 1974) 505 F2d 1297, 184 USPQ 38.

Allowable Subject Matter

8. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

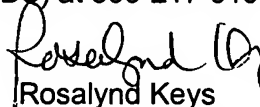
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9. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or fairly suggest use of a catalyst in the instant process that comprises either components b and/or c in addition to component a.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M-W & F 4-10pm; H 5:30am-5pm; Sat 8am-1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalynd Keys
Primary Examiner
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April 29, 2006